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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,601

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Yoshiharu Sato

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HAMRE, SCHUMANN, MUELLER & LARSON, P.C.

P.O. BOX 2902

MINNEAPOLIS, MN 55402-0902

EXAMINER

NOGUEROLA, ALEXANDER STEPHAN

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

04/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,601	Applicant(s) SATO, YOSHIHARU	
	Examiner ALEX NOGUEROLA	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 is/are rejected.
- 7) ☒ Claim(s) 3-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment of December 11, 2008 does not render the application allowable.

Status of the Rejections pending since the Office action of June 11, 2008

2. All previous rejections are withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim rejected under 35 U.S.C. 102(e) as being anticipated by Davies et al. US 6,733,655 B1 (“Davies”).

Davies discloses an analytical tool comprising:

a substrate (2),

a cover(22) bonded to the substrate (col. 05:10-16 – note adhesive layer and col. 05:20-26 – note that the cover is a “protective plastic cover tape”) ,

a capillary (18) formed between the substrate and the cover for moving a sample liquid from a sample liquid introduction port toward an air vent (See col. 05:38-41. Although an air vent is not identified one with ordinary skill in the art would recognize that when the layers shown in Figures 1-7 are properly assembled two lateral air vents will be inherently formed at the ends of a channel perpendicular to the downstream end of the capillary 18),

a first electrode (4b) formed on, the substrate and having a first end

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located in the capillary (may be inferred from Figures 1-7),

a second electrode (6b) formed on the substrate and having a second end located in the capillary downstream from the first end of the first electrode with respect to a flow direction of the sample liquid (may be inferred from Figures 1-7), and

a window (24) formed in the cover for checking whether the sample liquid is supplied into the capillary (col. 05:24-29),

wherein the window has a downstream edge located downstream from the second end of the second electrode to check whether the sample liquid is supplied beyond the second end of the second electrode (from Figures 1-7 one may infer that the window (24) as an edge located downstream of third electrode 8b).

Allowable Subject Matter

5. Claims 2-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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6. The following is a statement of reasons for the indication of allowable subject matter:

a) Claim 2 - the combination of limitations requires that “the window is formed at a region which avoids a position directly above the second end of the second electrode.” In Davies the window (24) is directly above the upstream and downstream edges of all three electrodes (inferred from Figures 1-7 and the stated purpose of the window, which is to allow visual conformation of whether enough sample has been applied).

b) Claims 3-5 depend directly or indirectly from allowable claim 2.

c) Claim 6 - the combination of limitations requires that “the window is provided by forming a transparent portion in the cover and forming an opaque portion around the transparent portion. “ In Davies the transparent member of the cover and the opaque portion of the cover are side-by-side. See Figure 7.

d) Claims 7-12 depend directly or indirectly from allowable claim 6.

e) Claim 13 - the combination of limitations requires "an additional window for checking whether introduction of the sample liquid into the capillary has started."

In Davies there is only one window in the cover. Also, since the window spans the full length of the capillary/sample chamber the start of the introduction of sample liquid into the capillary can be checked.

f) Claims 14-17 depend directly or indirectly from allowable claim 13.

Final Rejection

7. Applicant's amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (571) 272-1343. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alex Nogueraola/
Primary Examiner, Art Unit 1795
April 8, 2009